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10/044,059	01/11/2002	Satoshi Otsuka	204935-9001	6540

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Michael Best & Friedrich LLC
401 North Michigan Avenue
Chicago, IL 60611

EXAMINER

ADDY, ANTHONY S

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/044,059

Applicant(s)

OTSUKA, SATOSHI

Examiner

Anthony S Addy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:
 - Applicant should insert "a" on page 2, line 11 before "portable telephone".
 - "The" should be inserted before "communication" on page 3, lines 4-8.
 - "Manipulation unit 106" on page 4, line 22 should be corrected to "manipulating unit 106" as specified in Fig. 2 of the drawings.
 - "CPU 101" should be corrected to "CPU 104" as specified in Fig. 2.
 - "radio communication unit 100" should be changed to "radio communication unit 110" as specified in Fig. 2 of the drawings.
 - "ratio" on page 6, line 27 should be changed to "radio".
 - "main" on page 7, line 26 should be changed to "mail".
 - "includes" should be changed to "include" on page 8, line 24.

Appropriate correction is required.

2. Claim 4 is objected to because of the following informalities: "a" should be inserted before "communication" on page 12, line 3; "the " should be inserted before "communication" on page 12, lines 5-6.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. Regarding claims 1 and 2, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

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4. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "the arrival call and/or mail" on line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "the arrival call and /or an address for the mail" on lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claims 1-6 are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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6. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by **Kuno et al., U.S. Patent Number 6,473,628, (hereafter Kuno)**.

Regarding claim 1, Kuno teaches a portable telephone set having additional functions such as game functions (see col. 11 lines 17-19) as well as telephone functions (see col. 10 lines 44-47), where the additional functions other than the telephone functions are operated by stopping the operation of the telephone functions (see col. 11 lines 11-16 and col. 12 lines 29-31).

Regarding claim 2, Kuno discloses all the limitations of claim 1. In addition, Kuno teaches a manipulating means with a telephone function stop key for stopping the telephone functions (see col. 10 lines 51-54); a radio communicating means for performing communication with the outside (see col. 10 lines 56-58) and a control means for stopping the function of the radio communication means when the telephone function stop key in the manipulating means is manipulated (see col. 4 lines 54-59).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuno in view of Yoon (Yoon et al.; U.S. Patent Number 6,628,971).

Regarding claim 3, Kuno teaches all the limitations of claim 1 and 2. Kuno further shows a display means for displaying various data (see col. 10 lines 50-51).

Kuno, however fails to explicitly teach the control means is operative to render the radio communicating means operative when a predetermined time has passed after the stopping of the function of the radio communicating means, then check whether a mail addressed to the own station is present in the network, and in the case of the presence of a mail addressed to the self station, display a mail ICON indicative of the presence of the mail addressed to the own.

Yoon discloses a method for displaying background image in a mobile telephone, which downloads background images in a memory, and displays a selected one of the stored background images. The method comprises the steps of displaying the selected image for a predetermined time, in a background image request condition; determining whether an urgent character message display condition has occurred while the background image is displayed; upon detection of the urgent character message display condition, stopping the display of the background image and displaying the urgent character message (see col. 3, line 3 to col. 4 line 37 and Fig. 3).

It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to modify the telephone set of Kuno to display an urgent character message so that the telephone set will have that advantage, as per the teachings of Yoon.

9. Claims 4, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuno in view of Wells (Wells et al.; U.S. Patent Number 5,870,683).

Regarding claim 4, Kuno teaches a portable telephone set having an additional function unit (see col. 11 lines 17-19) as well as a communication function unit (see col.

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10 lines 44-47), the telephone set including stopping means for stopping the operation of the communication function unit (see col. 10 lines 51-54). Kuno does not teach the communication function unit being repeatedly operative for a predetermined time for checking the presence of the arrival of a call and /or mail to its own telephone set and displaying the arrival call and/or mail.

Wells, however, discloses a method for operating a wireless user terminal or mobile station to selectively display one of a plurality of graphical information sequences on a display of the mobile station. The graphical information sequence is displayed during an idle state of the mobile station, that is, when the mobile station is not involved in receiving a call or during a call. The graphical information can be displayed when the mobile station is in the Keyguard state (i.e. stopping of the communication function unit and being repeatedly operative), and/or in a charging state, or when the mobile station is first powered on (see col. 2, lines 15-25).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the telephone set of Kuno to display the arrival call and/or mail, as per the teachings of Wells.

Regarding claim 5, Kuno in view of Wells teaches all the limitations of claim 4. In addition Wells further teaches where a telephone number for the arrival call and/or an address for the mail are displayed (see col. 8, lines 64-66 and col. 9, lines 33-36).

Regarding claim 6, Kuno in view of Wells teaches all the limitations of claim 4. In addition Kuno further teaches an end button 19 for terminating calls (see col. 4, lines

66-67; where an end button is a stopping means that can also be used to stop power supply to the communication function unit).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rautila, U.S. Patent Number 6,524,189 discloses a multi-player game system using mobile telephone and game unit.

Thompson et al, U.S. Patent Number 6,484,011 discloses a non-telephonic wireless information presentation device.

Myers et al, Pub No.: 2004/005762 A1 discloses a method and apparatus for converting a voice signal received from a remote telephone to a text signal.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony S Addy whose telephone number is 703-305-8487. The examiner can normally be reached on Mon-Fri 7:3am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Erika A Gary can be reached on 703-308-0123. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

AA

ASA

June 30, 2004


ERIK GATT
PATENT EXAMINER